

dihydrobenzofuranyl or 2,3-dihydro-2-oxofuranyl,  
each optionally substituted by R<sup>3</sup> and/or R<sup>4</sup>.

#### **REMARKS**

#### **The Amendments**

The claims are amended to remove "Cl" from the definition of the R<sup>3</sup> and R<sup>4</sup> substituents. The claims are also amended in a formalistic manner to be more attune to US practice.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

#### **The Rejection under 35 U.S.C. §102**

The rejection of claims 1 and 15-17 under 35 U.S.C. §102, as being anticipated by Saakyan (CAPLUS), is believed to be rendered moot by the above amendment. The Saakyan compounds require tri-Cl substitution on the thiophene ring. The claims no longer encompass such substituted compounds. Thus, there is no anticipation and the rejection under 35 U.S.C. §102 should be withdrawn.

Further, it would not have been obvious to modify the Saakyan compounds to arrive at applicants' currently claimed compounds. Saakyan appears to only disclose a synthetic method and provides no indication of use for the compounds. Where a reference discloses no utility for compounds disclosed therein, the reference provides no motivation to one of ordinary skill in the art to modify such compounds even to compounds which are allegedly structurally similar. In re Stemniski, 170 USPQ 343 (CCPA 1971). As the court rhetorically asked in Stemniski, at 347:

" Where the prior art reference neither discloses nor suggests a utility for certain described compounds, why should it be said that a reference makes obvious to one of ordinary skill in the art an isomer, homolog or analog of related structure, when that mythical, but intensely practical, person knows of no 'practical' reason to make the reference compounds, much less any structurally related compounds?"

Thus, Saakyan also does not support a rejection under 35 U.S.C. §103.

### **The Withdrawn Method Claims**

Applicants respectfully submit that the withdrawn method of preparation claims, claims 2-11, should be rejoined with the compound claims – which in light of the above are believed to be allowable. If the compounds are novel and nonobvious, it logically follows that the method for making those compounds would be novel and nonobvious, i.e., if the compounds are not known or suggested, there is no motivation to provide a method for making them. Rejoinder of such claims is in accordance with the practice in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996), and the Commissioner's notice thereon at 1184 TMOG 86, March 26, 1996.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

Respectfully submitted,

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